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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,322	07/12/2001	Koichi Chotoku	275765US6	1810

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

DUNN, MISHAWN N

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/904,322	<b>Applicant(s)</b> CHOTOKU ET AL.	
	<b>Examiner</b> Mishawn N. Dunn	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The Examiner withdraws the rejection under the first paragraph of 35 U.S.C. 112 based on Applicant's amendment to further clarify the claims and more completely explain the evaluation value.
- 2.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: paragraph 6 of claim 1 should cite, "a thinning mechanism configured to reduce...". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 2 recites the limitation "a preservation mechanism" in line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Chotoku et al. (US Pat. No. 6,728,473).

The applied reference has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

8. Consider claim 1. Chotoku et al. teaches a video-signal recording and playback apparatus for recording and playing back a video signal of a television-broadcast program (fig. 1), said video-signal recording and playback apparatus comprising: a recording mechanism configured to record a video signal onto an information recording medium (col. 4, lines 31-37); an extraction mechanism configured to extract a representative picture from a video signal to be recorded (col. 5, line 67 – col. 6, line 1); an attachment mechanism to associate an evaluation value to a representative picture extracted by said extraction mechanism (col. 6, line 66 – col. 7, line 26); a preservation mechanism configured to preserve a representative picture extracted by said extracting mechanism in said information-recording medium (col. 8, lines 37-41); and a thinning mechanism configured to reduce a number of representative pictures preserved by said

preservation mechanism in said information-recording medium based on said evaluation value (col. 7, lines 42-58).

9. Consider claim 2. Chotoku et al. teaches a video-signal recording and playback wherein said extraction mechanism, said attachment mechanism, said preservation mechanism and said thinning mechanism are capable of carrying out their respective pieces of processing concurrently with processing carried out by said recording mechanism to record a video signal onto said information-recording medium (col. 8, lines 37-41).

10. Consider claim 4. Chotoku et al. teaches a video-signal recording and playback apparatus wherein said attachment mechanism is capable of attaching evaluation values to representative pictures in such a way that said evaluation values are dispersed along said time axis (col. 8, lines 28-36).

11. Consider claim 5. Chotoku et al. teaches a video-signal recording and playback apparatus according to claim 1 wherein said thinning mechanism is capable of carrying out a thinning process on representative pictures recorded by said preservation mechanism on said information-recording medium on the basis of resemblance of said representative pictures (col. 7, lines 42-57).

12. Consider claim 6. Chotoku et al. teaches a video-signal recording and playback method adopted in a video-signal recording and playback apparatus for recording and playing back a video signal of a television-broadcast program (fig. 1), said video-signal recording and playback method comprising: a recording step of recording a video signal onto an information-recording medium (col. 4, lines 31-37); an extracting step of

extracting a representative picture from said video signal to be recorded (col. 5, line 67 – col. 6, line 1); an attaching step of attaching an evaluation value to said representative picture extracted at said extracting step (col. 6, line 66 – col. 7, line 26); a preserving step of preserving said representative picture extracted at said extracting step in said information-recording medium (col. 8, lines 37-41); and a thinning step of carrying out a thinning process on a number of representative pictures preserved at said preserving step in said information-recording medium on the basis of said evaluation value attached by said attaching mechanism (col. 7, lines 42-58).

13. Consider claim 7. Chotoku et al. teaches a recording medium for storing a program to be executed by a video-signal recording and playback apparatus for recording and playing back a video signal of a television-broadcast program, wherein said program is a computer readable program (col. 9, lines 3-33), execution of instructions of program implement a method comprising: a recording step of recording a video signal onto an information-recording medium (col. 4, lines 31-37); an extracting step of extracting a representative picture from said video signal to be recorded (col. 5, line 67 – col. 6, line 1); an attaching step of attaching an evaluation value to said representative picture extracted at said extracting step (col. 6, line 66 – col. 7, line 26); a preserving step of preserving said representative picture extracted at said extracting step in said information-recording medium (col. 8, lines 37-41); and a thinning step of carrying out a thinning process on a number of representative pictures preserved at said preserving step in said information-recording medium on the basis of said evaluation value attached by said attaching mechanism (col. 7, lines 42-58).

***Allowable Subject Matter***

14. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US Pat. No. 5,809,202

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

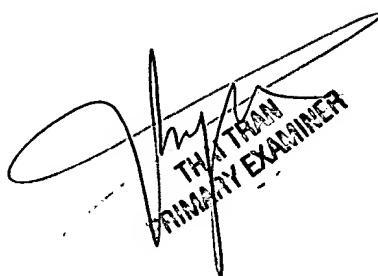
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mishawn Dunn  
April 12, 2006



THAT TRAN  
PRIMARY EXAMINER